

REMARKS

A. Status of Claims

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1-20 are pending. In this Amendment, Claim 12 is amended. No new matter is added. Any paragraph numbers below refer to the paragraph numbers in United States Published Patent Application No. 2004-0157074.

B. Response to Rejection of Claims 1-20 under 35 U.S.C. § 112, second paragraph.

At Section 2 of the Office Action, Claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed in part and obviated in part with respect to the claims as currently presented.

1. Rejection of Claim 12 obviated in part by above amendment to Claim 12.

The specific objection to Claim 12, line 2 has been obviated in part by the above amendment to Claim 12.

2. The Final Action has provided no proper basis for rejecting Claims 1-20, as currently presented, under 35 U.S.C. § 112, second paragraph.

Applicant respectfully but strenuously objects to the Final Action's characterization of the claims as being in "extremely poor condition." The Final Action provides no grounds in support of what Applicant considers a blatant mischaracterization of the claims which, as currently presented, are in full compliance with 35 U.S.C. § 112, second paragraph.

As set forth by the Manual of Patent Examining Procedure (MPEP) at § 2171, there are two separate requirements of 35 U.S.C. § 112, second paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

The Final Action provides no explanation as to why the term “covering product” fails to comply with the requirements of 35 U.S.C. § 112. Similarly, it provides no explanation as to why the phrases “a membrane comprising a thermoplastic” and “said fabric layer being comprised of a fabric material” in Claims 1 and 11 fail to comply with the requirements of 35 U.S.C. § 112, second paragraph.

The following comments in the Final Action also indicate that the rejections are based on a misunderstanding of the claimed invention:

. . . and the apparent method of contemplated use in the last two lines of article claim 1 seems unnecessary; i.e. does applicant ever envision any embodiments where the product would be sold after its added on adhesive surface was adhered to a building” (Final Action, p. 2).

As an ordinarily skilled artisan who read Applicant’s application would understand, the claimed invention involves an adhesive that is *pre-applied* to the fabric layer, i.e., is contacted with the fabric layer before the covering product is adhered to a building structure. This claimed feature distinguishes the claimed invention from a covering product that does not have an adhesive applied to its fabric layer prior to adhering the covering product to a building structure. For example, an adhesive might be spread on a building structure to allow a covering product including a fabric layer to be adhered to a building structure.

For at least the above reasons, the rejection of Claims 1-20 under 35 U.S.C. § 112, second paragraph is *prima facie* improper and should be withdrawn.

C. **The Rejection of Claims 1-20 under 35 U.S.C. § 103(a) over Venable ‘785 or ‘812, each taken in view of WO ‘866 is *prima facie* improper, because the Examiner has failed to provide an Affidavit/ Declaration under 37 C.F.R. § 104(d)(2) as properly requested by Applicant.**

In Applicant’s December 29, 2005, Amendment (December Amendment), Applicant noted that Claims 1-20 had been rejected under 35 U.S.C. § 103(a) over Venable ‘785 or ‘812, each taken in view of WO ‘866 based on facts within the personal knowledge of the Examiner and, therefore, requested that the Examiner provide an

Affidavit/Declaration under 37 C.F.R. § 104(d)(2) in support of the those allegations (See December Amendment, Section F, pp. 20-21). Because the Examiner has failed to provide this properly requested Affidavit/Declaration, the rejection of Claims 1-20 under 35 U.S.C. § 103(a) over Venable '785 or '812, each taken in view of WO '866 is *prima facie* improper for at least this reason and should be withdrawn.

D. The Comments in Section 3 of the Final Action fail to fully address the deficiencies of the Non-Final Office Action that were identified by Applicant and discussed in detail in Applicant's December Amendment.

At Section 3 of the Final Action, Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Venable '785 or "812, each taken in view of WO '866 for the reasons of record set forth in Paragraph 8 of the September 30, 2005, Office Action (Non-Final Office Action). This rejection is respectfully traversed.

Applicant identified numerous specific deficiencies in this rejection and discussed these deficiencies in detail in Section E of the December Amendment. However, the Final Action only cursorily addresses the arguments made in Section E of the December Amendment. In fact, the Final Action does not identify as incorrect a single specific detailed argument made by Applicant about the deficiencies of this rejection and these references.

The Final Action also makes additional new arguments that are unsupported by what the cited references teach and suggest. For example, the Final Action's newly alleged "motivation" for combining the references as set forth Section 3 is based merely on what the "Examiner . . . believes" and not what on what the references actually teach or suggest. Furthermore, the Final Action continues to fail to cite actual text in the cited references that teach or suggest the Final Action's alleged motivation for combining the cited references.

Therefore, for at least these reasons, the alleged "motivation" to combine the references set forth in Section 3 of the Final Action is insufficient in view of relevant Federal Circuit precedent such as *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), cited in Applicant's December Amendment, which requires that *specific reasons* must be shown in the art for suggesting a combination of references.

E. The Arguments set forth in Applicant's December Amendment have not been rebutted; therefore, the rejections of Claims 1-20 under 35 U.S.C. §§ 102(a) and 103(a) are *prima facie* improper and should be withdrawn.

For at least the above reasons, the arguments in Section E of Applicant's December Amendment were not rebutted in the Final Action. Therefore, the rejections of Claims 1-20 under 35 U.S.C. §§ 102(a) and 103(a) set forth in the Non-Final Office Action and affirmed by the Final Action are *prima facie* improper for at least the reasons set forth in Section E of Applicant's December Amendment.

F. Confirmation that rejection of Claims 1, 2, 4-7, 11 and 14-17 under 35 U.S.C. 102(a) over Hubbard has been withdrawn.

Because the rejection of Claims 1, 2, 4-7, 11 and 14-17 under 35 U.S.C. 102(a) over US 2003/00219564 to Hubbard (Hubbard) set forth in the Non-Final Action is not mentioned in the Final Action, Applicant assumes that this rejection has been withdrawn.

G. Confirmation that rejection of Claims 3, 8-10, 12, 13 and 18-20 under 35 U.S.C. 103(a) over Hubbard has been withdrawn.

Because the rejection of Claims 3, 8-10, 12, 13 and 18-20 under 35 U.S.C. 103(a) over Hubbard set forth in the Non-Final Action is not mentioned in the Final Action, Applicant assumes that this rejection has been withdrawn.

H. Confirmation that rejection of Claims 1-20 under 35 U.S.C. 103(a) over either Venable '785 or '812 in view of Hubbard has been withdrawn.

Because the rejection of Claims 1-20 under 35 U.S.C. 103(a) over either Venable '785 or '812 in view of Hubbard set forth in the Non-Final Action is not mentioned in the Final Action, Applicant assumes that this rejection has been withdrawn.

I. Claims 1-20 have been Rejected based on Facts within the Personal Knowledge of the Examiner; therefore, Applicant Requests that the Examiner provide an Affidavit/Declaration under 37 C.F.R. § 104(d)(2).

1. Claims 1-20 have been rejected over the cited references based on facts within the personal knowledge of the Examiner.

In Section 3 of the Final Action, the Examiner makes the following conclusory statement:

Additionally, the Examiner further believes that these and related process of making difficulties are general knowledge within the art, as is evidenced by these three citations, which when combined in the manner indicated, it is respectfully submitted, clearly overcome any allegations of hindsight such as applicant has made (Final Action, p. 3).

However, the above conclusory statement is unsupported by text from the references cited by the Examiner. Instead of being based on facts provided to the Applicant, the above conclusory statement is only based on what the Examiner believes is “general knowledge within the art” and what the Examiner believes the references. In fact, the Examiner has provided to Applicant no factual evidence that the difficulties specifically addressed by the claimed invention were “of general knowledge within the art.” Also, contrary to what is alleged in the above conclusory statement, the Examiner has provided to the Applicant no factual evidence to rebut the Applicant’s statements in Section E(4)(b) in the December Amendment that the rejection of Claims 1-20 over the cited references is based on improper hindsight.

In addition, the Final Action, just like the Non-Final Action, fails to provide the Applicant with any specific text that supports the Examiner’s allegations. For example, despite the Examiner’s allegations in that there would be motivation to combine the cited references (see Final Action, p. 3), the Final Action fails to provide the Applicant with any text from Venable ‘785 or Venable ‘812 or any other reference that shows why a person of ordinary skill in the art possessing only Venable ‘785 or Venable ‘812 would be motivated to look for WO ‘866. Because the Examiner has not provided such textual evidence to the Applicant, Applicant can only conclude that the Examiner has based his allegation that there is motivation to combine these references on additional facts of within his personal knowledge that have not been provided to Applicant.

The Examiner has also continued to fail to identify what elements of the cited references the Examiner believes correspond to the claimed features discussed in Section E(2) of the December Amendment. Therefore, the identities of these elements are also facts within the personal knowledge of the Examiner that have not been provided to the Applicant.

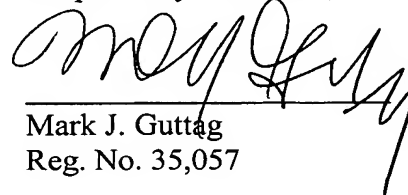
2. Applicant requests that the Examiner either: (a) provide an Affidavit under 37 C.F.R. § 1.104(d)(2), or (b) withdraw the rejections of Claims 1-20.

For at least the above reasons, Claims 1-20 have been rejected on the basis of facts within the personal knowledge of the Examiner. Accordingly, under 37 C.F.R. § 1.104(d)(2), Applicant hereby requests that the Examiner either: (a) provide affidavit(s) or declaration(s) which contain these facts supporting the Examiner's unsupported assertion used as a basis for the rejections of Claims 1-20 or (b) withdraw the rejections of Claims 1-20 based on the Examiner's unsupported assertions.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Mark J. Guttag at 703-591-2664, Ext. 2006.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,


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